

REMARKS

It is noted that, notwithstanding any claim amendments made herein, Applicant's intent is to encompass equivalents of all claim elements, even if amended herein or later during prosecution.

Claims 3-5, 11-14, 16-21, and 31-37 are all of the claims pending in the present Application. New claims 31-37 are added.

It is noted that the Examiner has changed his position from that of the Office Action dated October 2, 2003, in which the Examiner had indicated that claims 3-5, 11-14, 16-21 would be allowable. Applicants point out that they have already once relied on the Examiner's earlier position, including the expense of rewriting dependent claims in independent format and initiating a continuation for claims that the Examiner indicated were not allowable.

New claims 31-37 are added to bring the total claim count back up to the limit of 20 total claims and to claim additional features of the present invention that are not covered in the claim set that the Examiner had previously considered to be allowable. Since no new independent claims are included, there is no excess claims fee due to these additional claims.

According to the latest Office Action dated May 10, 2004, claims 5, 18, and 21 are allowed. Applicants gratefully acknowledge the Examiner's indication that claims 13 and 14 would be allowable if rewritten in independent format. However, Applicants decline to rewrite these claims in independent format at this time, since it is believed that the present invention, as defined by the independent claims is clearly patentable over the prior art of record, when properly understood and when a reasonable evaluation is conducted, as explained below.

In the latest Office Action, claims 3, 4, 11, and 12 stand rejected under 35 USC §103(a) as unpatentable over Japanese Patent JP 07-160203 to Satoru et al., further in view of US Patent 5,075,686 to Shigemura, and further in view of US Patent 5,905,914 to Sakai et al. Claims 16 and 17 stand rejected under 35 USC §103(a) as unpatentable over Satoru/Shigemura/Sakai, further in view of US Patent 6,339,696 to Chan et al. Claims 19 and 20 stand rejected under 35 USC §103(a) as unpatentable over Satoru/Shigemura/Sakai,

further in view of US Patent 6,144,358 to Narayanaswamy et al.

These rejections are respectfully traversed in view of the following discussion, since the piecemeal evaluation currently of record is clearly the result of improper hindsight.

I. THE CLAIMED INVENTION

As disclosed and described by, for example, claim 3, the present invention is directed to a vehicle-mounted apparatus, including a first panel including a first display. The first panel is mountable onto a surface of a vehicle. A second panel includes a second display, the second panel being openable and closeable with respect to the first display about a side thereof as an axis. There is an operating switch. A means is provided for changing a function indication on the operating switch according to whether the second panel is open or closed.

Advantages of the present invention over prior art configurations include that it provides a display/control apparatus that minimizes space and reduces complexity for the control switching.

Moreover, relative to the device taught in Satoru, the present invention provides a simple mounting technique (i.e., directly to the surface) that does not need an expensive and complex motor-driven mechanism. Additionally, the present invention provides a control panel on the back face of the second panel, thereby allowing more space on each panel to be devoted to the display function and provides a display configuration in which a portion of the first display can be left uncovered when the second panel is in the closed position, thereby allowing the exposed portion of the first panel to serve as a small display area when the panels are fully closed, relative to each other. In other embodiments, the display of the second panel can be used as an active display when the two panels are closed relative to each other.

II. THE PRIOR ART REJECTIONS

The Examiner alleges that claims 3, 4, 11, and 12 are rendered obvious by JP 07-160203 to Satoru et al., further in view of Shigemura, and further in view of Sakai et al.

As best understood, relative to the rejection for claim 3, the Examiner considers that

panel 13 of Satoru corresponds to the first panel of the claim and panel 14 corresponds to the second panel. The Examiner concedes that Satoru fails to incorporate an "... *operating switch changing a function indication according to at least one of whether [the] second panel is open/closed.*"

It is first noted that the evaluation is constrained by the plain meaning of the claim language. Accordingly, as described below, even if all of the prior art references were to be used to redesign Satoru, as urged by the Examiner, the combination would still fail to comply with the plain meaning of the wording of independent claims 3, 4, 5, and 11.

That is, the "first panel", as defined by claim 3, is required to be "mountable onto a surface of a vehicle." The panel 13 of is clearly mounted in casing 11 and, therefore, not at all mountable onto a surface of a vehicle. It is irrelevant that the casing 11 is or is not mounted on a surface, since that condition is not being described by the claims.

Moreover, the stowing and unstowing process of the two panels 13, 14 in Satoru involves an elaborate set of linkages, drive racks, pinions, and a motor so that the second panel 14 face remains exposed when the first panel 13 is stowed (e.g., see Drawing 2). Therefore, neither panel 13, 14 in Satoru is intended to be mounted on a surface. The Examiner cannot simply ignore this basic distinction between the present invention and Satoru.

In contrast, the present invention does indeed have a first panel that can be mounted directly on a surface of a vehicle in order to serve its intended role as, for example, a control panel or display for an entertainment system. The present invention does not have the elaborate mounting configuration of Satoru, and the description in the claims clearly differentiate from the mounting configuration of Satoru.

Second, Applicants submit that the plain meaning of the independent claim language requires that "... *said second panel being openable and closable with respect to said first display about a side thereof as an axis.*"

In contrast, it is clear that the second panel 14 of Satoru never closes (e.g., it is always exposed to the operator). That is, comparing Drawing 2 with Drawing 1, it is clear that panel 14 is always open. Nor can it reasonably be described that panel 14 is open/closed relative to panel 13, since Drawing 2 clearly shows that panel 13 is never "closed" relative to panel 14. The stowed panel 14 is at most "perpendicular to" panel 13 but cannot be reasonably

described as "closed".

Indeed, Applicants submit that the motion in Satoru is the opposite motion to a relative closing of the displays of the two panels 13, 14, since the stowed position of the lower panel 13 causes the displays to be even further opened relative to each other. Again, Applicants submit that the plain meaning of the claim language clearly differentiates from the configuration shown in Satoru and that the Examiner cannot simply ignore this second clear distinction.

The Examiner relies on Shigemura to teach switching that changes function, upon Sakai for an operating switch, upon Chan to teach an audio/video source, and upon Narayanaswamy to teach detecting a position. None of these references overcome the basic deficiency identified above for Satoru.

Hence, turning to the clear language of the claims, in Satoru there is no teaching or suggestion of: "... said first panel being mountable onto a surface of a vehicle ... said second panel being openable and closeable with respect to said first display about a side thereof as an axis....", as required by the independent claims. Therefore, all claims are clearly patentable over Satoru, if for no reason other than dependency.

It is further noted that Satoru could not be modified to accommodate these above-identified features of the present invention, since such modification would clearly defeat the principle of operation of the mounting of the apparatus shown in Satoru. Such modification would clearly violate MPEP §2143.01: "*THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE.*"

Moreover, if the panel 13 of Satoru were to be mounted to a surface of a vehicle or panel 13 and 14 modified so that panel 13 opens/closes relative to panel 14 or even that panel 14 closes, such revision would clearly render that apparatus inoperable, clearly violating a second guideline of MPEP 2143.01: "*THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE.*"

Therefore, Applicants submit that Satoru simply cannot serve as the primary reference in evaluation of the present invention.

Moreover, relative to the Examiner's urged combination of references, Applicants again submit that the rejection currently of record simply "pieces together" elements extracted

from different references until the primary reference Satoru has been completely redesigned to read on the present invention.

Applicants submit that this analysis technique is clearly improper hindsight, since there is no suggestion in the prior art references to make the modifications to arrive at the claimed invention and since the redesign would be incompatible with the purpose and operation of the primary reference Satoru. It is noted that the analysis for obviousness is not an exercise in which the Examiner redesign the prior art reference(s) until a combination reads on the invention described by the claims.

That is, as clearly described in MPEP §2143.01: "*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*" [emphasis in MPEP itself]

In the rejection currently of record the Examiner merely recites the missing element and then summarily declares that it would be obvious to incorporate this element because another reference describes the purported function or benefit of the missing element. The Examiner seems to forget that the primary reference Satoru is already a completely functioning apparatus. Therefore, there is no reason to modify Satoru, absent hindsight.

The Examiner's evaluation process is improper under MPEP §2141.02: "*In determining the differences between the prior art and the claims, the question under 35 U.S.C 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.*" [emphasis in MPEP itself]

As Judge Rader recently wrote in the Federal Circuit Court of Appeals holding in *Ruiz v. A.B. Chance Co.*, Federal Cir., No. 03-1333, January 29, 2004:

"In making the assessment of differences, section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. Envtl. Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements."). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of

invention." (Emphasis Applicants')

Although the holding in that case left undisturbed, under the "clear error" standard of review, the conclusion of the District Court that the prior art references were properly combinable, it specifically explained that it declined to reverse this conclusion because "... the two references address precisely the same problem ..." (emphasis by Applicants)

This aspect of the *Ruiz* holding, in which precisely the same problem is being addressed by the references, is not present in the prior art references of the current rejection. As pointed out above, the Examiner simply extracts isolated elements from a number of prior art references and uses them to totally redesign the primary reference.

Moreover, the evaluation currently of record makes multiple redesigns in the evaluation so that a first modification is immediately revised in order to seize upon a first subcomponent aspect of a first secondary reference but thereafter to discard the remainder of the first secondary reference in order to further modify the first subcomponent in accordance with a second aspect of a second secondary reference. This piecemeal picking and choosing is clearly the hindsight that Judge Rader describes as improper.

More specifically, Satoru's purpose is "To efficiently house display members in the display device and to widen the substantial area of a screen at the time of use." (See Abstract) To achieve this purpose, Satoru requires that the first display panel 13 be stowed inside a chassis when not in use (e.g, to protect it from possible damage from striking the shift lever, as explained in paragraph [0004]).

The Examiner relies upon Shigemura in combination with Sakai to overcome the deficiency that Satoru fails to teach or suggest having an operating switch for which a function indication changes when the second panel is open or closed relative to first panel.

First, as noted above, the second panel of Satoru is always open. It is never closed, let alone being closed relative to the first panel.

Second, the Examiner relies upon Shigemura as teaching a group of switches that change input functions when a cover is open/closed.

In response, Applicants submit that Satoru does not have a cover, let alone a cover that opens/closes. Nor does Satoru describe a keyboard environment in which there is a need

to change over the function of the keys for two applications. The Examiner cannot simply redesign the primary reference Satoru.

Moreover, a fair reading of Shigemura clearly discloses that this reference clearly teaches against using an opening/closing cover (e.g., lines 48-58 of column 1 explains the disadvantages of such covers) to install instead the sliding control switch 51 and associated slide sheet 53 taught therein.

In terms of Judge Rader's rationale in the Riuz holding, the purpose of Shigemura is not at all the same as that of Satoru, let alone being precisely the same purpose. That is, the purpose in Shigemura is to address the problems identified with the opening/closing covers on a control panel environment having switches arranged in a matrix (e.g., such as a facsimile machine). Shigemura solves these problems by eliminating this type of cover and converting to a sliding switch configuration that eliminates the problems identified in column 1. It is noted that the purpose of this secondary reference Shigemura is, therefore, actually to eliminate the modification upon which the Examiner relies.

In contrast, the purpose of the primary reference Satoru is to modify the display members of the prior art automotive display apparatus shown in Drawings 12 and 13 to prevent possible damage from the shift lever 4 and to widen the display area of the display.

Because of these basic different purposes, one of ordinary skill in the art for automotive display devices would not be looking for additional modifications for the Satoru device in prior art references that are not even related in purpose, such as Shigemura. Moreover, Applicants submit that one of ordinary skill in the art would certainly not be inclined to modify Satoru in the manner in which Shigemura expressly teaches against. Again, the Examiner's piecemeal redesign of Satoru ignores this aspect of Shigemura and is, therefore, a clear indication of impermissible hindsight.

Similarly, the rest of the secondary references, Sakai, Chan, and Narayanaswamy, have purposes that differ from the purpose of Satoru. Therefore, in accordance with *Ruiz*, the Examiner is not entitled to simply extract isolated features of these secondary references in a piecemeal fashion to redesign Satoru, particularly when Satoru already functions in accordance with its intended purpose and there no suggestion therein to further modify it to address other unrelated problems.

In more detail, returning to the redesign of Satoru, as best understood, the Examiner first modifies Satoru to introduce a cover. However, if this modification is the intent of the Examiner, the rejection currently of record fails to provide a motivation to modify Satoru. Satoru does not need a cover and would not benefit from such a cover, let alone a cover that changes an indication on a control switch. Nor is it certain which switches on Satoru is to subject to the cover incorporated from Shigemura. As noted above, Shigemura at lines 48-58 of column 1 expressly teaches against this modification. Absent some clarification on the record, the Examiner's introduction of a cover on the upper panel would only impose into Satoru the problems specifically solved by Shigemura. It is noted that the present invention does not incorporate the sliding switch and sliding display configuration taught by Shigemura as eliminating the problems that the Examiner's modification would introduce into Satoru.

As best understood, in the next step of the analysis, the Examiner then relies upon Sakai, wherein a "panel switch" 156 detects whether a display panel is open/closed and directs image data accordingly. As best understood, the Examiner is attempting to further modify Satoru/Shigemura to now replace the cover incorporated into Satoru in accordance with Shigemura with a "panel switch" that serves the purpose in Sakai to direct video data to a display panel if that display panel is open. As best understood, the Examiner is also additionally somehow reconfiguring Satoru/Shigemura so that the cover added in accordance with Shigemura, now replaced by a "panel switch" is now somehow further modified so that the indication of a control switch function on Satoru is now converted into video data.

In summary, Applicants respectfully submit that the above technical analysis would not be considered reasonable by one of ordinary skill in the art. It would be inconsistent on its face and would ignore the engineering reality of all of the three prior art references.

Applicants submit that, as a technical evaluation, the Examiner has the initial burden to provide a reasonable motivation to modify the apparatus of Satoru. As pointed out above, the apparatus of Satoru already functions and there is no reason to modify it. If the Examiner wishes to redesign Satoru to somehow improve it, the Examiner has a burden to clearly explain what modifications are occurring and provide a reasonable motivation.

More specifically, if the Examiner insists on incorporating a cover of some type, he must specify exactly how Satoru is to be modified to have this cover incorporated and why

one of ordinary skill in the art would be motivated to modify the perfectly-functioning apparatus of Satoru to include a cover, let alone a cover such as in Shigemura in which inputs are changed in accordance with a position of the cover. Second, Applicants submit that it would clearly be hindsight for the Examiner to then replace the just-incorporated cover with a "panel switch" that detects a display panel position (e.g., not the position of a cover), which "panel switch" has a function to direct image data to a display panel when the display panel is open.

Applicants additionally submit that the rejection currently of record for the Examiner's urged combinations with Chan and Narayanaswamy have the same basic deficiency in that the Examiner merely extracts features from these references having different purposes from that of Satoru and incorporates these features into Satoru with a conclusory statement that such modifications would be obvious since the combination would achieve the benefit of having made the modification. As Judge Rader's quote above indicates, such piecemeal evaluation discounts the purpose of having patent protection for new combinations of known elements.

Therefore, Applicants submit that claims 3-5, 11-14, and 16-37, all the claims currently pending in the Application are clearly patentable over Satoru.

The prior art references currently of record clearly do not show a vehicle-mounted apparatus similar to that of the present invention.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicants submit that claims 3-5, 11-14, and 16-37, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

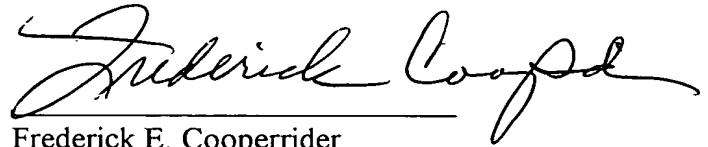
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18

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: 7/22/04

A handwritten signature in cursive script, reading "Frederick E. Cooperrider", written over a horizontal line.

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